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Attorney's Docket No.: 08914-009001

### REMARKS

Claims 2-11 have been amended to overcome formal objections and have not been narrowed. The claims are presented without narrowing amendments for reconsideration.

1. Claims 2-11 stood rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In claims 2 and 6-11, the use of the word "its" was considered indefinite, and in claim 4, line 1, "the web portions" was said to lack proper antecedent basis. These claims have been amended to overcome these formal objections without amendments that narrowed the elements being amended.

2, 3. Claims 1, 6 and 11 stood rejected under 35 U.S.C. §103(a) as being unpatentable over Jung as a primary reference in view of Momemers as a secondary reference. The primary reference is said to teach a key-holder comprising a band 11, spiral key-ring 15 and D-ring having a V-shaped portion connecting one end of the band and the key-ring. The D-ring is said to further comprise a gap portion to be attached to the band and a clip means 20/21/22 to clamp the other end of the band together. The primary reference fails to teach a D-ring having a U-shaped portion. The secondary reference is said to teach a similar key-ring comprising a D-ring with a U-shaped portion 3. It is said it would have been considered an obvious matter of design choice to substitute a U-shape for the V-shape of the primary reference. Furthermore, the method limitations of claim 11 are said to be considered inherent to the device of the primary reference as modified by the secondary reference. This ground of rejection is respectfully traversed.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989).

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"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

"The critical inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

As the Federal Circuit Court of Appeals said in *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999):

Close adherence to this methodology is especially important of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'

And in *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), the Court said:

[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* [*Dembiczak*]. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *See In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998), *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *See B. F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

Nothing in the primary or secondary references suggests the desirability of combining what is there disclosed to meet the terms of these rejected claims. Furthermore, the primary

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reference not only fails to disclose the D-ring, but does not disclose the band. The primary band discloses a combined nail clipper and key holder which comprises a nail clipper housing including a hollow portion provided with a pair of lateral grooves disposed on opposite walls of the housing, the housing further including an aperture disposed at the rear end and a key ring connecting member rotatably attached to the front end.

The secondary reference discloses a key keeper having a key-retaining loop 3 with an opening 17 for receiving keys, the loop being connected to a loop holder being slidably mounted within the housing. The function of loop 3 is to retain keys, not to couple anything to a key ring.

The alleged teaching is found, not in the references but in the claims being rejected. It is error to reconstruct the claimed invention from the prior art by using the rejected claim as a "blueprint." *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 548 (Fed. Cir. 1985).

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.<sup>15</sup> This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."<sup>16</sup> *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992).

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<sup>15</sup> *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).  
See also *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

<sup>16</sup> *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600.

Here, the Examiner is attempting to use the claims being rejected as blueprints or templates for attempting to read elements in the prior art on the claims. This is improper.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992).

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It is impossible to combine the references to meet the terms of the rejected claims. That is reason enough for withdrawing the rejection of claims 1, 6 and 11 on the primary and secondary references.

Still further, the consideration that the proposed combination is "an obvious matter of design choice" is a conclusion, not a reason for sustaining a rejection under Section 103.

In *In re Garrett*, 33 PTCJ 43 (BPA&I, September 30, 1986) the Board criticized the Examiner's statement that the proposed modification would have been "an obvious matter of engineering design choice" as a conclusion, not a reason, in reversing the section 103 rejection.

The assertion that the method limitations of claim 11 are considered inherent to the admittedly novel device is not a proper basis for rejecting claim 11.

"In the absence of the article in the prior art we find no basis for the conclusion that the manipulative steps of assembling the nonexistent article would be obvious." *Ex parte Rubin*, 127 U.S.P.Q. 286, 287 (Bd. of Appeals 1959).

If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the references regarded as corresponding to each element in each rejected claim, and quote verbatim the language in the references regarded as suggesting the desirability of combining what is there disclosed to meet the terms of these rejected claims.

4. Claims 2, 4, 7 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the primary reference in view of the secondary reference as applied to claim 1 and further in view of Chen as a tertiary reference. The tertiary reference is said to teach a web material for a key holder 16. It is said it would have been obvious to one of ordinary skill in the art to modify the band of the primary reference to be a flexible web material as said to be taught by the tertiary reference to be easier to handle and store. This ground of rejection is respectfully traversed. The reasoning set forth above in support of the patentability of claim 1 over the primary and secondary references is submitted to support the patentability of claims 2, 4, 7 and 9 so that further discussion of the tertiary reference is submitted to be unnecessary. However, nothing in the tertiary reference suggests the desirability of substituting flexible web material for the housing of the primary reference. Moreover, the substitution proposed by the Examiner would destroy the function of the primary reference in forming a housing for the nail clipper.

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In *Ex parte Sternau*, 155 U.S.P.Q. 733, 735 (Bd. of Appeals 1967) the Board said:

However, there is nothing in the disclosures of [primary reference] Young and [secondary reference] Haslachner that would teach the Examiner's proposed combination or any reason for making it. In fact, the proposed combination would destroy the Young apparatus for its intended purpose. Thus, we will reverse the rejection of claims 44 and 45 for this reason.

Accordingly, withdrawal of the rejection of claims 2, 4, 7 and 9 as unpatentable over the primary reference in view of the secondary and tertiary references is respectfully requested. Should this ground of rejection be repeated, the Examiner is respectfully requested to quote verbatim the language in the references regarded as corresponding to elements in the rejected claims and quote verbatim the language in the references regarded as suggesting the desirability of making the combination proposed by the Examiner.

5. Claims 3, 5, 8 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the primary, secondary and tertiary references as applied to claim 2 and further in view of Sheldon as a quaternary reference. The quaternary reference is said to teach a key holder comprising a band 10 having a U-shaped or V-shaped D-ring at one end and a clamp 20 for the other end of the key holder band. It is said it would have been obvious to one of ordinary skill in the art to modify the clamp means 20/21/22 of the primary reference by providing a clip-type clamp as said to be taught by the quaternary reference as an obvious matter of design choice.

This ground of rejection is respectfully traversed. The reasoning set forth above in support of the patentability of claim 2 over the primary, secondary and tertiary references is submitted to support the patentability of claims 3, 5, 8 and 10 so that further discussion of the quaternary reference is submitted to be unnecessary. Furthermore, the assertion that it would have been obvious to modify the clamp means 20/21/22 of the primary reference by providing a clip-type clamp as said to be taught by the quaternary reference "as an obvious matter of design choice" is a conclusion not a reason that supports a rejection under section 103. Accordingly, withdrawal of the rejection of claims 3, 5, 8 and 10 as unpatentable over the primary, secondary, tertiary and quaternary references is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in each reference

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regarded as corresponding to an element in a rejected claim and quote verbatim the language in the references regarded as suggesting the desirability of combining what is disclosed in the references to meet the terms of the rejected claims.

6. The courtesy of the Examiner in conducting a diligent search is acknowledged with appreciation. The references cited, but not applied, are submitted to be incapable of anticipating, suggesting or making obvious the subject matter as a whole of the invention disclosed and claimed in this application.

In view of the foregoing non-narrowing amendments, authorities, remarks and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe this application is not in a condition for allowance, she is respectfully requested to telephone the undersigned attorney at (617) 521-7014 to discuss what additional steps she believes may be necessary to place the application in a condition for allowance.

Attached is a marked-up version of the changes being made by the current amendment.

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Enclosed is a \$55 check for the Petition for Extension of Time fee, the original of which will arrive under separate cover. Please apply any other charges or credits to Deposit Account No. 06-1050, Order No. 08914-009001.

Respectfully submitted,

FISH &amp; RICHARDSON P.C.

NOV 19 2001

Date: \_\_\_\_\_



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Version with markings to show changes made

CLAIMS

Claims 2, 4, and 6-11 have been amended as follows:

2. (Amended) A key ring in accordance with claim 1 wherein the band is a web of material having ends looped through the D-ring and joined at [its] said ends.
4. (Amended) A key ring in accordance with claim 2 wherein the web has portions that are fastened together for most of their length to define an opening accommodating the bar of the D-ring so that the D-ring may rotate about the axis of the bar through an angle of nearly 360 degrees and the key-holding ring may ride along the inside portion of the U-shaped portion of the D-ring about an axis perpendicular to the axis of the bar and perpendicular to the band for substantially 180 degrees.
6. (Amended) A key ring in accordance with claim 1 where said key-holding ring is a spiral ring of material having a cross-sectional span with ends and said bar is formed with a gap intermediate [its] said ends of width about that of said span to allow said key-holding ring to pass through said gap into said D-ring during assembly.
7. (Amended) A key ring in accordance with claim 2 wherein said key-holding ring is a spiral ring of material having a cross-sectional span and said bar has ends and is formed with a gap intermediate said [its] ends of width about that of said span to allow said key-holding ring to pass through said gap into said D-ring during assembly.



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8. (Amended) A key ring in accordance with claim 3 wherein said key-holding ring is a spiral ring of material having a cross-sectional span and said bar has ends and is formed with a gap intermediate said [its] ends of width about that of said span to allow said key-holding ring to pass through said gap into said D-ring during assembly.

9. (Amended) A key ring in accordance with claim 4 wherein said key-holding ring is a spiral ring of material having a cross-sectional span and said bar has ends and is formed with a gap intermediate said [its] ends of width about that of said span to allow said key-holding ring to pass through said gap into said D-ring during assembly.

10. (Amended) A key ring in accordance with claim 5 wherein said key-holding ring is a spiral ring of material having a cross-sectional span and said bar has ends and is formed with a gap intermediate said [its] ends of width about that of said span to allow said key-holding ring to pass through said gap into said D-ring during assembly.

11. (Amended) A method of making a key ring that includes a key-holding ring that is a spiral ring of material having a cross-sectional span, a band, a D-ring coupling said band to said key-holding ring and having a U-shaped portion engaging the key-holding ring and a bar having bar ends between the ends of the U-shaped portion formed with a gap intermediate said bar [its] ends of width about that of said span to allow said key-holding ring to pass through said gap into said D-ring during assembly, comprising,

passing the key-holding ring through the gap into the D-ring,

and passing the band through the D-ring.